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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,671	10/09/2001	Hidetaka Magoshi	100809-16271 (SCEY 19.057	5777
26304 7590 12/29/2006 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER BOVEJA, NAMRATA	
			ART UNIT 3622	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/29/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/973,671

Applicant(s)

MAGOSHI, HIDETAKA

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/09/2001 and 2/14/2002.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. This office action is in response to communication filed on 09/26/2006.
2. Claims 1-20 are presented for examination.
3. Amendments to claims 2, 5, 8, 11, 12, 14, and newly added claims 18-20 have been entered and considered.

### Objections

4. Claims 1, 4, 7, and 16 are objected to because of the following informalities. The claims recite "at least one of the frequency **and** the quantity of," instead of "at least one of the frequency **or** the quantity of." Appropriate correction is required.

### Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-19 are rejected under 102(b) as being anticipated by *Marino et al.*

*Patent Number 4,850,007 (hereinafter Marino).*

In reference to claims 1, 4, 7, and 16, *Marino* teaches a method, program, a computer-readable recording medium, and a program-executing apparatus of providing services that makes a computer execute the steps of: making service beneficiaries select at least one of the frequency and the quantity of advertising to be added the services provided (*col. 4 lines 44-60*), the services being provided when the selection is made (*col. 4 lines 1-15 and 44-60*); and setting a fee for the provision of services to the

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service beneficiaries, according to at least one of the frequency and the quantity of advertising selected (*col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20*).

6. In reference to claims 2, 5, 8, 11, and 14, *Marino* teaches the method, computer-readable medium of providing services, the program-executing apparatus (*i.e. a monitor or television set*), the contents distribution system (*i.e. a databank*), and the computer-readable recording medium recorded with a contents distribution program (*i.e. software*) that makes a computer execute the steps of setting fees wherein the fees charged for the services to be provided to the service beneficiaries are set at discrete stages (*i.e. a rate reduction per call*) of the frequency and the quantity of advertising selected by the selecting means of the client terminal unit (*col. 1 lines 54-58, col. 2 lines 36-41, and col. 4 lines 16-20*); and at least one of the discrete stages includes free of charge (*i.e. coupons good for the purchase of merchandise or services could be the form, in whole, or in part, that the caller may receive as value for his cooperation*) (*col. 2 lines 36-41*).

7. In reference to claims 3, 6, and 9, *Marino* teaches a method, computer-readable medium, and the program-executing apparatus of providing services and the program-executing apparatus, wherein, at least one of the frequency and the quantity advertising selected can be changed during the provision the services (*i.e. can select how many minutes of advertising you want to see and/or hear*) (*col. 4 lines 44-60*).

8. In reference to claim 10, *Marino* teaches a contents distribution system, comprising: client terminal unit connected to a predetermined network (*i.e. a phone connected to a network*), and having selecting means (*i.e. having buttons*) for selecting at least one of the frequency and the quantity advertising be added to the contents be

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distributed (*col. 4 lines 53-60 and Figure 1*); and distribution unit having distribution means distributing the contents added with the advertising corresponding to least of frequency and the quantity selected by the selecting means of the client terminal the client terminal via the predetermined network (*i.e. a monitor, television screen, and/or telephone*) (*col. 4 lines 1-4 and 53-60 and Figure 1*), and charging means for charging a fee for the contents distributed to the client terminal unit (*i.e. billing portion*) (*col. 4 lines 16-20 and Figure 2*), according to at least one of the frequency and the quantity of advertising selected by the selecting means the client terminal unit (*col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20*); wherein the selecting means communicates with the distribution means to perform the selection (*i.e. based on the user selection, advertisements are selected from the databank and provided to the user*) (*col. 1 lines 49-54 and col. 4 lines 53-60*).

9. In reference to claims 12 and 15, *Marino* teaches the contents distribution system wherein the client terminal unit has changing means for assigning a change and the computer-readable recording medium comprising and making a computer assign a change in at least one of the frequency and the quantity of advertising during the reception of the contents (*i.e. user can select how many minutes of advertising the user wants to see and/or hear*) (*col. 4 lines 53-60*), the changing means including an interface (*i.e. a phone pad is an interface*) adapted to accept a modification of the selection of at least one of the frequency and the quantity of advertising to be added to the contents to be distributed (*i.e. user can select to hear other advertisements detailing a given advertisement*) (*col. 2 lines 26-29*), and the distribution means of the distribution

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unit adds the advertising according to at least one of the frequency and the quantity changed by the changing means of the client terminal unit, and distributes the contents added with the advertising to the client terminal unit (*i.e. based on the user selection, advertisements are selected from the databank and provided to the user*) (col. 1 lines 49-54 and col. 4 lines 53-60).

10. In reference to claims 13 and 17, *Marino* teaches a computer-readable recording medium recorded with a contents distribution program and a contents distribution program, the contents distribution program comprising and making a computer execute the steps of: making a client terminal unit connected to predetermined network select at least one of the frequency and the quantity of advertising to be added to the contents to be distributed (*i.e. user can select how many minutes of advertising the user wants to see and/or hear*) (col. 4 lines 53-60); making a distribution unit connected to the predetermined network add the advertising corresponding to at least one of the frequency and the quantity selected by the client terminal unit to the contents, and distribute the contents added with the advertising to the client terminal unit (col. 1 lines 49-54 and col. 4 lines 1-15 and lines 57-60); and making the distribution unit charge a fee for the contents distributed to the client terminal unit (*i.e. billing portion*) (col. 4 lines 16-20 and Figure 2), according to at least one of the frequency and the quantity of advertising selected by the client terminal unit (col. 1 lines 54-58, col. 2 lines 37-41, and col. 4 lines 16-20); wherein the contents are distributed when the selection is made (col. 4 lines 53-60).

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11. In reference to claim 18, *Marino* teaches the method of providing services wherein the selection is received via a user interface (*i.e. the user selects the number of minutes of advertisements via the phone*) (col. 4 lines 53-60); and the services are provided via the user interface (*i.e. the advertisements are sent via the phone*) (col. 4 lines 53-60).

12. In reference to claim 19, *Marino* teaches the method of providing services wherein: the provision of the services is interrupted when the advertisement information is being received by the user (col. 3 lines 16-41 and col. 4 lines 1-11), and the provision of services is restarted after the receiving of the advertisement information is completed (col. 4 lines 1-11).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 20 is rejected under U.S.C. 103(a) as being unpatentable over *Marino* in view of Official Notice.

In reference to claim 20, *Marino* teaches the method of providing services wherein the service beneficiaries select the quantity of advertising to be added to the services provided. *Marino* does not teach selecting the frequency of advertising to be added to the provided services. Official Notice is taken that is well known to select the

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*frequency of advertising to be added to provided services as done by online users on amazon.com when they sign up for a reminder service to remind themselves about upcoming birthdays on a weekly basis.*

*Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include selecting the frequency of advertising to be added to the provided services to enable the user to automatically receive specified number of advertisements without seeking out the advertisements manually on a per call basis and to save the user time in completing each phone call.*

### **Response to Arguments**

14. After careful review of Applicant's remarks/arguments filed on 04/27/2006, the Applicant's arguments with respect to claims 1-18 and the newly added claims 19 and 20 have been fully considered but are moot in view of the new ground(s) of rejection. Amendments to the claims have both been entered and considered.

15. The 112 Rejections are being removed, since the Applicant's amendments to the claims sufficiently addresses the issues previously raised by the Examiner in this case.

16. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

### **Conclusion**

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Abecassis Patent Number 6,553,178. Teaches an advertisement subsidized video on demand system.



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- b) Song Patent Number 6,865,546. Teaches the methods and systems of assisting users in purchasing items including a reminder service from the amazon.com website.

**Point of Contact**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **Central FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).



N.B.

December 7, 2006



**RAQUEL ALVAREZ**  
**PRIMARY EXAMINER**